

REMARKS

1. The Office Action indicates that it is responsive to communications filed on 12 December 2000 and that Claims 1-25 were pending in the application. However, a Preliminary Amendment was submitted in this application which was received at the Patent Office on 10 October 2001 (see the enclosed Exhibit "A", consisting of the Preliminary Amendment and the Patent Office acknowledgement.) The Preliminary Amendment added Claims 26-37. Unfortunately, the Examiner has not considered these claims in preparation of the above identified Office Action. Applicant is of the opinion that Applicant's remarks will place the application in allowable condition, including those claims not yet considered. Applicant is also of the opinion that should the Examiner not accept Applicant's basis for overcoming the Examiner's rejections based on art and further reject the claims, it would not be consistent with Patent Office rules or practice to make additional Office Action a Final Office Action because Applicant's additional claims have not yet been considered. Again, Applicant believes that this issue is moot based on the Applicant's submission of a Declaration Under 37 C.F.R. 1.131 removing the Examiner's primary references prior art (see below).
2. Claims 1-7, 9,10, 13-17, 19, 20, 22, and 25 have been rejected by the Examiner under 35 U.S.C. § 102 (e) as being anticipated by Smith, US Patent Number 5,533,124. Applicant notes that Smith issued on 2 July 1996 and was filed on 7 December 1994. The subject application is a continuation of application serial number 08/398,862, which was filed on 6 March 1995.

Under 37 C.F.R. § 1.131 (see MPEP 715), a prior art reference under 35 U.S.C. § 102(e) can be avoided by showing reduction of practice prior to the effective date of the reference or conception of the invention prior to the effective date of the reference coupled with due diligence from prior art to the date of the reference to a subsequent reduction to practice or to the filing of the application. In the above mentioned parent application, which led to the present application, Applicant had submitted a declaration under 37 C.F.R. § 1.131 to overcome a rejection under 35 U.S.C. 102(e) in view of Smith et. al.

Applicant submits herewith the following documents, which were submitted in the parent application in connection with the Smith reference:

- a) A Response received at the Patent Office on 7 October 1996 indicating that the Smith reference is avoided pursuant to a declaration under 37 C.F.R. § 1.131 by the Inventor Tyler Peppel (Exhibit B);
- b) An Amendment After Final received at the Patent Office on 31 March 1997, which includes the Second Declaration, Under 37 C.F.R. § 1.131 by the Inventor Tyler Peppel and supporting documentation (Exhibit C);
- c) A Decision on Appeal mailed 13 March 2000 by the Board of Patent Appeals and Interferences in connection with the prosecution of the parent application, including the Board's decision with regard to the Declaration under 37 C.F.R. § 1.131 of the Inventor Tyler Peppel (Exhibit D);
- d) A Response Based on Decision on Appeal dated 11 April 2000, in which the Applicant addresses the issues raised by the Board of Patent Appeals and Interferences (Exhibit E); and
- e) A Notice of Allowance and Issue Fee Due in which the Examiner provides as reason for allowance the following statement:

Based on the Board's decision and the Appellant's amendment and declaration in response thereto this application appears to be allowable over the prior art of record (Exhibit F).

Applicant submits these documents in connection with the subject application as a basis for avoiding the Smith reference under 37 C.F.R. § 1.131. The basis for allowance in the parent application was the Examiner's acceptance of Applicant's Declaration under 37 C.F.R. § 1.131 as a basis for avoiding the Smith reference in that application. Here, the same reference forms the basis for rejection under 35 U.S.C. § 102(e). The facts are the same, the dates are the same, and Applicant's previously submitted declaration is equally as

applicable to the subject application as it was to the parent application. The only difference is that the claims in the subject application were not presented in the parent application. However, Applicant's attorney submits herewith a declaration of Applicant's Attorney under 37 C.F.R. § 1.131 in which Applicant's attorney affirms that the subject matter claimed in the present application is not the same as set forth in the claims of the cited reference.

Accordingly, the Smith reference is avoided and the claims subject to rejection thereunder are deemed to be in allowable condition.

3. 35 U.S.C. § 103. In view of the allowability of the independent claims submitted herewith, the rejections under 35 U.S.C. § 103 for obviousness of dependent claims are deemed moot. Further, such rejections are mooted in the view of Applicant's avoidance of the Smith reference pursuant to Applicant's declaration to 37 C.F.R. § 1.131.
4. Applicant noted at the outset that the claims which accompanied applicants Preliminary Amendment were not examined. Applicant is of the opinion that the avoidance of Smith as a reference hereunder renders any further consideration of such claims moot in that such claims should be allowable as well as Claims 1-25 which were considered under the Office Action. Should the Examiner determine that Smith is to be asserted against the claims contained in the Preliminary Amendment, Applicant submits that the Declaration Under 37 C.F.R. § 1.131 which is now being applied to Claims 1-25 equally applies to the claims contained within the Preliminary Amendment.

CONCLUSION

The application is now considered in condition for allowance and Applicant requests the Examiner forward to Applicant a Notice of Allowance in due course. Should the Examiner deem it helpful, the Examiner is encouraged to contact the Applicant's Attorney, Michael A. Glenn, at (650) 474-8400 to discuss the application.

Respectfully submitted,



Michael A. Glenn

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